

PATENT APPLICATION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q62966

Kazunori UKIGAWA, et al.

Appln. No.: 09/775,591

Group Art Unit: 3693

Confirmation No.: 9264

Examiner: Jason M. BORLINGHAUS

Filed: February 5, 2001

For: ACCOUNT SETTLEMENT METHOD IN ONLINE SHOPPING

REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.41, Appellant respectfully submits this Reply Brief in response to the Examiner's Answer dated September 10, 2007. Entry of this Reply Brief is respectfully requested.

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REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41
U.S. Application No.: 09/775,591

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STATUS OF CLAIMS

Claims 1-24 are all the claims pending in the present application. Claims 3, 4, 14, 15, 17, 21, and 24 are withdrawn from consideration. Claims 1, 2, 5-13, 16, 18-20, and 22-23 have been finally rejected, and are the subject of this appeal.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1, 2, 5, 6, 12, 13, 16, 20, and 23 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Koreeda (US Patent No. 5,890,137) in view of O'Leary (US Patent No. 6,609,113).
2. Claims 7, 9-11, 18, and 22 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Koreeda in view of Dogac (Dogac, Asusman, Ozsu, M. Tamer & Ulusoy, Ozjur. Current Trends in Data Management Technology. Idea Group Publishing,, Hershey, PA. 1999. pp. 41-42) and Davis (Davis, Steven. Pragmatics: A Reader. Oxford University Press. New York, New York. 1991. pp. 217-219).
3. Claims 8 and 19 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Koreeda, Dogac, and Davis, and in further view of Lomax (Lomax, Paul. *Learning VBScript*. O'Reilly & Associates, Inc. Sebastopol, California. 1997. pp. 457-459).

ARGUMENT

In the *Response to Arguments* section of the Examiner's Answer, the Examiner responds to Appellants' arguments set forth in the Appeal Brief dated May 24, 2007. In response, Appellants maintain that the present invention, as claimed, is patentable over the applied references at least based on the previously submitted arguments and the arguments set forth below.

A. Koreeda in combination with O'Leary does not render claims 1, 2, 5, 6, 12, 13, 16, 20, and 23 unpatentable under 35 U.S.C. § 103(a).

A1. Koreeda and O'Leary's systems are so incompatible as to prevent even conceptual combination.

In the Appeal Brief dated May 24, 2007, Appellants argued that one of ordinary skill in the art would have been prevented from deriving the claimed invention from O'Leary and Koreeda because the two references teach fundamentally different architectures and are incompatible.

That is, Appellants argued, in part, that the system of O'Leary, and in particular, the wallet 215 thereof, is implemented in such a different way with respect to the system disclosed in Koreeda that the two references could not have been combined by one skilled in the art. The wallet 215 of O'Leary, as detailed above, provides the sole and exclusive path for communication between a user workstation 200 and a merchant 255. In contrast, Koreeda teaches that there are two separate lines of connection from the user system 5: one being the link via network 4 between a user system 5 and a merchant site 2 and the other being the link via

network 6 between a user system 5 and a settlement means 13. Because O'Leary uses a single path through a wallet 215 and can get the product information in its role as intermediary, and because Koreeda must use parallel and independent paths, only one of which is through a service center 7, the two systems would not be viewed as compatible. Moreover, one of ordinary skill would not consider placing the wallet at the service center location, because there exists a separate network 4 for communication between the user and the merchant. *See pages 11-19 of Appeal Brief for full argument.*

O'Leary

In the *Response to Arguments* section of the Examiner's Answer, the Examiner alleges, in part:

In both Koreeda and O'Leary, a user accesses a merchant site and selects a product to purchase, the user sends information to an agent device, either termed a service center (Koreeda) or a wallet (O'Leary), which then routes information back to the merchant site upon completion. The Examiner fails to see the structural differences which would make the two systems incompatible.

Page 19 of Examiner's Answer.

In response, first, Appellants submit that O'Leary does not disclose the sequence of actions alleged by the Examiner in the paragraph above. The Examiner alleges that a user accesses a merchant site and selects a product for purchase, the user sends information to an agent device, a wallet in O'Leary, and the wallet routes information back to the merchant site upon completion. As indicated in the previously filed Appeal Brief, no pre-existing relationship has to exist between a customer and a merchant in O'Leary prior to information being sent to the wallet in O'Leary. In O'Leary, when a user and a workstation 200 launches a browser 210 and seeks to make a purchase using online shipping, a PPP enhanced wallet 215 can be used to

effectuate a purchase, initiate the payment through a payment authorization to the consumer's bank 220, verify the accuracy of the merchant's payee information (identification of the merchant's account 235 at the merchant's bank 275), generate a purchase confirmation 244 that is transmitted to the merchant website 255, and generate a receipt that can be stored at the server hosting the PPP enhanced wallet 215 or the user's storage (see col. 10, lines 14-35). In other words, O'Leary teaches providing a user with real time purchase and payment ability when the user is attempting to make a purchase via a merchant website. Thus, the wallet 215 primarily acts as a portal between a workstation 200 and a merchant site to initiate and complete payment for a purchase. The PPP enhanced wallet has a personal data storage and form filling capability. Thus, no pre-existing relationship has to exist between a customer and a merchant prior to the implementation of the wallet 215. As evidenced above, the Examiner's characterization of the system of O'Leary and the premise upon which the Examiner bases his arguments are not supported.

Koreeda

With respect to previously submitted arguments regarding Koreeda, the Examiner alleges, in part (on page 20 of Examiner's Answer):

The cited passage does not state that the networks are separate, although some passages state that the networks "may" be separate. However, Koreeda also states that the service center could exist within the same computer network as the shopping mall, perhaps as a subcomponent of the overall system.

In the on-line shopping system, the shopping mall network may be a computer network that can be accessed by a third party, and the settlement network may be a network set separately between the user system and the service center.

In the on-line shopping system, the shopping mall network may be Internet.

In the on-line shopping system, the settlement network may be formed by a public line, wherein the first protocol may be Point-to-Point Protocol, wherein the second protocol may be a protocol which is used between the shop system and the approval center for a shopping by the credit card.

A payment settlement method may include a store system offering shopping malls, a user system that may select a product to be purchased from the shopping malls, a credit card company system that may approve a payment settlement with a credit card, and a service center which may exist amend the store system, the user system and the credit card company system, the payment settlement method may further include... "(emphasis added, see col. 3, lines 40 - 59).

In response, Appellants submit that the above-quoted passage of Koreeda in its full context is not indicating that a service center could exist within a same computer network as a shopping mall. The above-quoted passage of Koreeda in its full context is a preamble to a claim. The preamble is stating that a particular payment settlement method may include a store system, a user system, a credit card company system, and separately a service center. This portion of Koreeda also states that the service center may exist among the store system, the user system, and the credit company system. This section of Koreeda is not intended to indicate that the service center exists within the same computer network as a shopping mall, as the Examiner alleges.

Therefore, yet again, the premises upon which the Examiner bases his rejections are not supported.

Yet further, the Examiner alleges (pages 20-21 of Examiner's Answer):

Appellant asserts that O'Leary operates differently to that of Koreeda, as O'Leary has only one line of communication, a line of communication between "a workstation 200 and a merchant site." However, O'Leary states:

The user's log-in to the PPP enhanced Wallet 215 is secure and encrypted to protect the confidentiality of any financial information associated with the operation of the PPP enhanced Wallet 215. Once accessed, a window containing the PPP enhanced Wallet 215 is launched on the workstation 200 and remains open during the user's session. The PPP enhanced Wallet 215 window has the ability to communicate with other open browser windows. In a preferred embodiment, the user's connection to the PPP enhanced Wallet 215 is through the Internet. In an alternative embodiment, the connection from the user's workstation 200 to the PPP enhanced Wallet 215 software can be through a separate dial up line or third party private network. (emphasis added - see col. 9, lines 49 - 61).

The cited passage indicates that the line of communication connecting the user with the agent device, such as the wallet, may be a separate line of communication than the line of communication connecting the user and the merchant site.

In response, Appellants acknowledge that O'Leary does state that an alternative

embodiment thereof could include a user's workstation 200 being connected to a PPP enhanced wallet 215 through a separate dial up line or third party private network. However, this portion of O'Leary does not preclude the single line of communication between the workstation and merchant site via the wallet 215. That is, the cited portion of O'Leary discusses a third embodiment of a user connecting to a PPP enhanced wallet 215 through the internet, however, in an alternative embodiment, a user workstation can connect to an enhanced wallet 215 via a separate dial up line or third party private network. Thus, via that same (single) dial up line or third part private network, a user workstation can connect to the merchant site. Therefore,

Appellants maintain that O'Leary does in fact disclose only one line of communication, as previously argued.

A2. Even if combined Koreeda and O'Leary do not suggest the use of ID information as a purchase instruction.

First, on pages 21 and 22 of the Examiner's answer, the Examiner responds to Appellants characterizations of Koreeda on page 13 of the Appeal Brief, and the Examiner states that he is unable to locate claims that relate to the characterizations of Koreeda set forth on page 13.

In response, Appellants submit that the statements with respect to Koreeda on page 13 of the Appeal Brief were not intended to imply that such features that are not in Koreeda are in the claimed invention.

Further, Appellants previously argued, in part, that the applied references, either alone or in combination, do not disclose or suggest at least that a user device includes a first purchase-instruction sending means for sending ID (identification) information of a user, as a first purchase instruction, together with information regarding the product input by the purchase-instruction inputting means. That is, Koreeda sends no user ID information as a purchase instruction. Further, O'Leary does teach that a certification process 205 is used to identify the user to the wallet, including the use of a user ID and password. However, this is a separate certification and is not a "purchase instruction" as claimed, as it is not accompanied by information regarding a product, as claimed. *See pages 19-20 of Appeal Brief.*

In response, the Examiner disagrees and alleges, in part (pages 22-24 of Examiner's Answer):

Appellant argues that there is no disclosure that a user sends a purchase instruction for sending user ID information, as a purchase instruction, together with regarding the product from the user to an agent device, Examiner information respectfully disagrees.

.....

O'Leary states:

As one of its primary functions, the PPP enhanced Wallet 315, though the functions provided by the PPP 227 serves as the portal to an Internet Payment Account (IPA) or a DDA account 230 described in more detail below. In a preferred embodiment the PPP enhanced Wallet 215 stores the following types of information: Form filling information such as credit card numbers, debit card numbers, shipping addresses, alternate shipping addresses, frequent flyer accounts, membership discounts (e.g., AAA, AARP), loyalty programs and e-mail addresses; Discount information such as e-coupons, rebates and merchant-specific spending certificates; Points or miles accrued for use of the accounts associated with the PPP 227; and Convenience information such as frequently paid VPL #'s (described below), bill payment account #'s, receipts, e-commerce bookmarks, shopping lists. A preferred download folder is installed on the user's local hard drive. The PPP enhanced Wallet 215 has pull down menus that are used to select, edit, update, sort, import and export any of the above information.

Upon receipt of an electronic purchase message from a merchant web site 255 as will be further described below with respect to the method of FIG. 2. the PPP enhanced Wallet 215 user is able to: 1) approve a purchase; 2) initiate the payment through a payment authorization to the consumer's bank 220; 3) verify the accuracy of the merchant's payee information (identification of the merchant's account 235 at the merchant's bank 275); 4) generate a purchase confirmation 244 that is transmitted to the merchant web site 255 or VPL

reporter 240; and 5) generate a receipt that can be stored at the server hosting the PPP enhanced Wallet 215 or the user's storage (e.g., hard drive) on workstation 200. (emphasis added - see col. 9, line 62 - col. 10, line 35).

Examiner asserts that such excerpts disclose a user sending a purchase instruction (purchase approval) for sending user ID information (form-filled information such as shipping information or e-mail addresses), as a purchase instruction (purchase submission), and information regarding the product (discount information) from the user to an agent device (the wallet).

According to Appellants' understanding, it appears that the Examiner believes that a purchase approval by a PPP enhanced wallet 215 satisfies the claimed purchase instruction. However, since no pre-existing relationship has to exist between a customer and a merchant in the invention of O'Leary prior to information being sent to the wallet, Appellants maintain that O'Leary does not satisfy the feature of a user device including a first purchase instruction sending means for sending ID information of a user, as a first purchase instruction, together with information regarding the product input by the purchase instruction inputting means. That is, since no pre-existing relationship exists between a customer and a merchant, clearly there is no sending of ID information of a user, as a first purchase instructions, together with information regarding the product input by the purchase instructions inputting means.

A3. Even if combined, Koreeda and O'Leary do not disclose or suggest an "agent device" that responds to user "ID information."

Appellants maintain the arguments set forth on pages 20-21 of Appeal Brief.

A4. The Appellants' attack on the failure of the combination of references to teach the claimed invention is not an attack on the references individually but on their combination.

Appellants maintain the arguments set forth on page 22 of Appeal Brief.

A5. Applied References Do NOT Teach the Limitations of Claims 2, 5, 6, 12, 13, and 16.

Appellants maintain the arguments set forth on pages 22-23 of Appeal Brief, as the Examiner does not respond to the specific arguments set forth on these pages.

Specifically, Appellants maintain that independent claim 6 is patentable at least based on reasons similar to those set forth above and in the Appeal Brief with respect to claim 1. For example, the Examiner has not demonstrated that the applied references, either alone or in combination, satisfy the operation of preregistering ID information of a user, information regarding the user, and information regarding settlement means held by the user in association with each other in a database of the agent device. At least since the Examiner has not demonstrated that the wallet 215 of O'Leary is an agent device having all of the features of the claimed device, specifically, the expressly defined relation to the user ID information, Appellants maintain that claim 6 is patentably distinguishable over the applied references, either alone or in combination.

Appellants maintain that independent claim 16 is patentable at least based on reasons similar to those set forth previously with respect to claims 1 and 6 (claimed computer device in claim 16 corresponds to the agent device recited in claims 1 and 6).

Appellants maintain that independent claims 12, 13, 20 and 23 are patentable at least based on reasons similar to those set forth above with respect to claim 1. Appellants maintain that dependent claims 2 and 5 are patentable at least by virtue of their dependencies from claim 1.

B. Koreeda in combination with Dogac and Davis do not render claims 7, 9-11, 18, and 22 unpatentable under 35 U.S.C. § 103(a).

With respect to claim 7, 9-11, 18 and 22, Appellants maintain that one of ordinary skill in the art having common sense would not have been led to combine Davis with Koreeda and/or Dogac, to arrive at the present invention.

Appellants recognize that the Examiner, in the Examiner's Answer, now relies on the recent KSR Int'l Co. v. Teleflex (KSR) decision to support the combining of Dogac with Davis and Koreeda. However, Appellants maintain that even if a less rigid approach is applied to the facts here, such as a common sense approach, a person of ordinary skill in the art having common sense at the time of the invention would not have reasonably looked to Davis, which relates to indirect and direct speech acts of an individual in a restaurant inquiring about what form of payment a store may take, with Koreeda and O'Leary, which are directed to technical inventions. That is, these references would not be combined by an artisan having common sense at the time of the invention at least based on reasons set forth above as well as those set forth in the previously filed Appeal Brief.

Further, Appellants note that the Examiner mentions O'Leary on pages 26 and 27 of the Examiner's Answer with respect to the rejections of claims 7, 9-11, 18, and 22. Appellants respectfully request that the Examiner issue a new non-final Office Action if the Examiner now (for the first time) relies on O'Leary in addition to the other applied references to support the rejections of claims 7, 9-11, 18, and 22, as the Examiner had not previously applied O'Leary to support the rejections of these claims. To apply O'Leary at this stage is clearly improper.

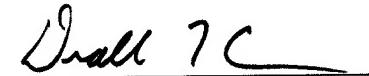
Yet further, Appellants submit that Dogac merely remarks on Shopbot's automatic learning capacity that involves extracting product description on home pages that have searchable index. This remark provides no specific disclosure about how the system should be configured in order to achieve the above-mentioned capability.

Further, Davis's report is concerned about a particular problem: what is the most efficient strategy for a credit card user to ask a human (merchant) which one of the cards the credit card user owns, the merchant accepts. Therefore, Davis is not about determining the means for settlement for each product.

CONCLUSION

For the above reasons as well as the reasons set forth in Appeal Brief, Appellant respectfully requests that the Board reverse the Examiner's rejections of all claims on Appeal. An early and favorable decision on the merits of this Appeal is respectfully requested.

Respectfully submitted,



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